

IV. Remarks

Claims 1–39 were previously pending.

Claims 13-30 and 33-39 were allowed in the present Office Action.

Claims 1, 2, 9-12, 31 and 32 were rejected in the present Office Action.

Claims 9 and 32 have been amended.

Claims 1-8, 10-31 and 33-39 have been maintained in their previously-presented form.

As a result, claims 1-39 are pending.

Reconsideration of claims 1-39 is respectfully requested in light of the above amendments and the following remarks.

Allowable Subject Matter

Applicants acknowledge and appreciate the allowance of claims 13-30 and 33-39.

Double Patenting

Claims 1, 2 and 31 of the presented application stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-5 of copending Application No. 10/504,361. More particularly, claims 1 and 2 of the present application stand provisionally rejected as unpatentable over claim 1 of Application No. 10/504,361, and claim 31 stands provisionally rejected as unpatentable over claims 1 and 3-5 of Application No. 10/504,361.

In response, Applicants file herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the provisional rejection. Applicants make clear that the filing of the terminal disclaimer to obviate the rejection under the judicially-created doctrine of obviousness-type double patenting is not an admission of the propriety of the rejection (see MPEP §804.02(II)). Accordingly, withdrawal of the provisional rejection of claims 1, 2 and 31 is respectfully requested.

Claims 3-8 depend from, and further limit, claim 1 in a patentable sense and therefore are allowable as well.

Rejections Under §102(b)

Independent claim 9

Claim 9 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,697,442 to Baldrige ("Baldrige"). Insofar as it may be applied against amended claim 9, this rejection is respectfully traversed.

Amended claim 9 recites: A shoe, comprising:

an upper annular portion;

an expandable intermediate annular portion coupled to the upper annular portion;
and

a lower annular portion coupled to the intermediate portion;

wherein, when the intermediate annular portion is expanded, the intermediate annular portion has an outer circumference that is larger than the outer circumferences of the upper and lower annular portions.

The PTO provides in MPEP §2131 that:

"[t]o anticipate a claim, the reference must teach every element of the claim."

Therefore, to support a rejection under 35 U.S.C. §102(b) with respect to claim 9, a reference must contain all of the above-claimed elements of the claim. However, Baldrige does not teach, suggest or motivate a shoe, comprising an upper annular portion; an expandable intermediate annular portion coupled to the upper annular portion; and a lower annular portion coupled to the intermediate portion; wherein, when the intermediate annular portion is expanded, the intermediate annular portion has an outer circumference that is larger than the outer circumferences of the upper and lower annular portions.

In contrast to claim 9, Baldrige does not teach, suggest or motivate an expandable intermediate annular portion coupled to the upper annular portion.

In further contrast to claim 9, Baldrige does not teach, suggest or motivate a shoe wherein, when the intermediate annular portion is expanded, the intermediate annular portion has an outer circumference that is larger than the outer circumferences of the upper and lower annular portions.

As a result, the previous rejection based on 35 U.S.C. §102(b) cannot be supported by Baldridge. Therefore, it is respectfully requested that the rejection of claim 9 under 35 U.S.C. §102(b) over Baldridge be withdrawn.

Dependent claims 10-12

Claims 10-12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Baldridge. Claims 10-12 depend from, and further limit, claim 9 in a patentable sense and therefore are allowable for at least the same reasons as noted above with respect to claim 9.

Independent claim 32

Claim 32 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Baldridge. Insofar as it may be applied against amended claim 32, this rejection is respectfully traversed.

Amended claim 32 recites: A shoe, comprising:

an upper annular portion;

an intermediate annular portion coupled to the upper annular portion including one or more inward folds that are adapted to be unfolded; and

a lower annular portion coupled to the intermediate portion including a valveable fluid passage for controlling the flow of fluidic materials out of the shoe;

wherein, when the one or more inward folds are unfolded, the intermediate annular portion has an outer circumference that is larger than the outer circumferences of the upper and lower annular portions.

As discussed above, a reference must teach every element of a claim for the reference to anticipate the claim. However, Baldridge does not teach, suggest or motivate a shoe, comprising an upper annular portion; an intermediate annular portion coupled to the upper annular portion including one or more inward folds that are adapted to be unfolded; and a lower annular portion coupled to the intermediate portion including a valveable fluid passage for controlling the flow of fluidic materials out of the shoe; wherein, when the one or more inward folds are unfolded, the intermediate

annular portion has an outer circumference that is larger than the outer circumferences of the upper and lower annular portions.

In contrast to claim 32, Baldridge does not teach, suggest or motivate an intermediate annular portion coupled to the upper annular portion including one or more inward folds that are adapted to be unfolded.

In further contrast to claim 32, Baldridge does not teach, suggest or motivate a shoe wherein, when the one or more inward folds are unfolded, the intermediate annular portion has an outer circumference that is larger than the outer circumferences of the upper and lower annular portions.

As a result, the previous rejection based on 35 U.S.C. §102(b) cannot be supported by Baldridge. Therefore, it is respectfully requested that the rejection of claim 32 under 35 U.S.C. §102(b) over Baldridge be withdrawn.

Conclusion

It is believed that all matters set forth in the Office Action mailed March 28, 2006 have been addressed. Applicants have made a diligent effort to advance the prosecution of this application by amending claims 9 and 32, submitting the attached Terminal Disclaimer, and submitting arguments in support of the patentability of claims 1-39.

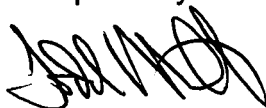
In view of all of the above, the allowance of claims 1-39 is respectfully requested.

Unless stated otherwise, the amendments to the claims were not made for reasons substantially related to the statutory requirements for patentability.

Furthermore, unless stated otherwise, the amendments to the claims were made to simply make express what had been implicit in the claims as originally worded and therefore none of the amendments to the claims is a narrowing amendment that would create any type of prosecution history estoppel. In addition, to the extent that any formerly dependent claim is now presented in independent form, such an amendment does not constitute a narrowing amendment that surrenders any subject matter.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

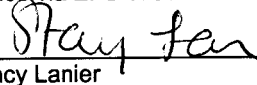


Todd D. Mattingly
Registration No. 40,298

Dated: June 27, 2006

HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 713/547-2301
Facsimile: 214/200-0853
File: 25791.50.06
d-1445170v1

Attachment: Terminal Disclaimer

<p align="center">Certificate of Service</p> <p>I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on June 27, 2006</p> <p align="center"> Stacy Lanier</p>
--